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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/681,490

10/07/2003

Gilbert Thill

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EXAMINER

SWITZER, JULIET CAROLINE

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

01/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/681,490

Applicant(s)

THILL, GILBERT

Examiner

Juliet C. Switzer

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)); to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-12 and 14-23.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


JULIET C. SWITZER
PRIMARY EXAMINER

Continuation of 3. NOTE: Regarding (a), the new limitation to claims 1 and two add a requirement that was not previously present in the claims, namely that the internal single stranded region be of at least 15 nucleotides. This requirement was not previously present in the claims and is a new issue that would require further consideration. Further, the amendment to claims 1 and 2 raise new issues for consideration under 112 2nd because it is not clear how a single stranded region of 15 nucleotides can COMPRISE a deletion; further clarification may be required. Because the amendments raise new issues, they (c) are not deemed to place the application in better form for appeal. Further, the amendment cancels two claims and adds six claims.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant summarizes the rejection of record and provides a review of some case law regarding motivation in obviousness inquiries. Insofar as applicant is attempting to suggest there was no motivation to combine the references, express motivation is cited in the rejection.

On page 8 of the remarks, applicant submits that the rejection is based on improper hindsight reasoning because there is no teaching, suggestion or motivation that would have led one of ordinary skill in the art to modify the disclosure of Brown et al. with the teachings of Wickremasinghe et al. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The rejection clearly sets forth the elements in the claims as they are found in the prior art and provides express motivation to combine the references.

ON page 9 applicant reiterates that Brown et al. do not teach a step of eluting the DNA from the BDNC column. This is a piecemeal analysis that does not consider the totality of the rejection.

On page 10 applicant states that an "inherency" is not proper in a 103 rejection. Applicant refers to MPEP 2112. This section of the MPEP clearly states, however, that "The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)." In this case, the motivation to combine the references is not reliant on the inherent aspect of the invention, but it is the case that the inherent feature would have been present once the methods were combined. The reliance on this teaching is therefore appropriate.

Applicant further argues that claims 14 and 19 were mischaracterized. However, this is not persuasive. Though the specification excludes certain embodiments, limitations from the specification are not read into the claims. Further, while nucleotide differences of "only a few base pairs" are specifically excluded, this is not equivalent to more than 15 base pairs. If applicant found the examiner's interpretation of the claim to be so inappropriate, the proper time to raise this concern would have been after the first action on the merits when the interpretation was first set forth. Further, regarding the amendment that was not entered, since Brown et al. specifically teach comparing eukaryotic genomes (in particular human genomes of high complexity (Col. 3, near line 40), the comparison of these two genomes would necessarily result in single stranded regions of 15 or more nucleotides since relative to one another any two human genomes would contain pseudogenes, deletions, translocations, gene homologues, gene loss events, rearrangements, flipping of genes, etc. Thus, even if the amendment had been entered, it would not have been persuasive to overcome the rejection of record.